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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/730,917 | 12/10/2003 | Teruaki Itoh | 160-402 (AMK) | 6712 |
| 23117 | 7590 | 10/09/2007 | | |
| NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203 | | | EXAMINER WRIGHT, PATRICIA KATHRYN | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/730,917 | Applicant(s) ITO, TERUAKI | |
| | Examiner P. Kathryn Wright | Art Unit 1743 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>6/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of the Response by Applicant, filed July 17, 2007, in which claims 2, 5 were canceled and claims 8-9 added. Claims 1, 3-4, 6-9 are currently pending. An action on the merits follows.
2. Any objection/rejection not repeated herein has been withdrawn by the Office.

Information Disclosure Statement

3. The information disclosure statement filed June 04, 2007 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each Japanese patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites that the inserting section comprises a cylindrical body and at

Art Unit: 1743

least one tapered annular flange extending across a radial width larger than the container. This is confusing and indefinite since the claim is drawn to a stopper, not a combination of a stopper and a container. That is, the container is not positively recited in the claim; thus, it is not clear how to determine the radial width of the stopper flange with respect to that of the container. Clarification is requested.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by C. J. Jesnig (US Patent No. 2,848,130).

Jesnig teaches a stopper for a tubular container 10. The stopper comprises an inserting section 37 and a closing section 56, 57 integrally connected to the inserting section. The closing section has a flat surface 16 (Fig. 3) that is configured to close an opening of the container when brought into intimate contact with a rim of the container opening (see Figs. 20, 21). The inserting section is formed of an elastically deformable liquid-tight member (see col. 6, lines 38+). The inserting section also includes a cylindrical body 33 having a tapered annular flange 34 projected from the cylindrical body such that the tapered annular flange presses against the inner surface of the tube-shaped specimen container to seal the container in fluid-tight manner.

Note that the claims are drawn to the stopper, not the combination of container and stopper. The container is not positively recited in the claim and therefore considered an intended use. The recitation with respect to the manner in which a claimed apparatus is intended to be employed, (i.e., liquid-tightly pressed on an inner surface of the container) fails to differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim (i.e., structural limitation of the stopper). *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

With respect to claim 3, the annular flange section includes a plurality of notches 40 or channels 60 which allow the flange to readily collapse the diameter of the insertion section to assist in the placing the insertion section of the stopper into the container, see col. 6, lines 38-45.

8. Claims 1, 3-4, 6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Rumpler (US Patent No. 4,193,402).

Rumpler teaches a stopper for a tubular container 15. The stopper comprises an inserting section 2 and a closing section 1 integrally connected to the inserting section. The closing section is configured to close an opening of the container when brought into intimate contact with a rim of the opening (see Fig. 5). The inserting section is formed of an elastically deformable liquid-tight member (see col. 4, lines 15+). The inserting section also includes a cylindrical body having a plurality of tapered annular flanges 5, 6

projected from the cylindrical body such that the tapered annular flange presses against the inner surface of the tube-shaped specimen container to seal the container.

Note that the claims are drawn to the stopper, not the combination of container and stopper. The container is not positively recited in the claim and therefore considered an intended use. The recitation with respect to the manner in which a claimed apparatus is intended to be employed, (i.e., liquid-tightly pressed on an inner surface of the container) fails to differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim (i.e., structural limitation of the stopper). *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

With respect to claim 3, the annular flange section includes a plurality of notches 7 which allow the flange to readily collapse the diameter of the insertion section to assist in the placing the insertion section of the stopper into the container, see Fig. 5.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over C. J. Jesnig (US Patent No. 2,848,130) in view of Gerarde (US Patent No. 3,902,477).

The teachings of Jesnig have been previously summarized, *supra*. Jesnig does not explicitly teach the insertion section and closing section being formed of polypropylene resin (claim 7).

Gerarde teaches a stopper 30 including, *inter alia*, an inserting section and a closing section 29. The inserting section has a cylindrical body 28 for insertion into a container 10, see for example Fig. 1. The container and stopper of Gerarde are made of an inert material, in particular, polypropylene resin since it does not react with or in any way adversely affect the specimen to be stored therein (see col. 2, line 3+).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to have made the container and stopper system Jesnig from polypropylene resin, as taught by Gerarde, since polypropylene does not react with or in any way adversely affect the specimen to be stored therein (see col. 2, line 3+).

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to determine the optimum materials of construction based on considerations such as cost, ease of manufacture, reactions with the processing agents and/or maintaining the required reaction conditions with respect to temperature.

11. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rumpler (US Patent No. 4,193,402) in view of Gerarde (US Patent No. 3,902,477).

The teachings of Rumpler have been previously summarized, *supra*. Rumpler does not explicitly teach the insertion section and closing section being formed of polypropylene resin (claims 7 and 8).

Gerarde teaches a stopper 30 including, *inter alia*, an inserting section and a closing section 29. The inserting section has a cylindrical body 28 for insertion into a container 10, see for example Fig. 1. The container and stopper of Gerarde are made

of an inert material, in particular, polypropylene resin since it does not react with or in any way adversely affect the specimen to be stored therein (see col. 2, line 3+).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to have made the container and stopper system of Rumpler from polypropylene resin, as taught by Gerarde, since polypropylene does not react with or in any way adversely affect the specimen to be stored therein (see col. 2, line 3+).

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to determine the optimum materials of construction based on considerations such as cost, ease of manufacture, reactions with the processing agents and/or maintaining the required reaction conditions with respect to temperature.

Response to Arguments

12. Applicant's arguments filed July 17, 2007 have been fully considered but they are not persuasive. With respect to the previous rejection of claims 1-3 under 35 U.S.C. 102(b) as being anticipated by C. J. Jesnig (US Patent No. 2,848,130), Applicant argues that stopper of claim 1 does not require the tube-shaped container to include an internal bead or ring 12, as taught in Jesnig.

In response to applicant's argument that the Jesnig reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., container) is not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read

Art Unit: 1743

into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As pointed out above, the claim is drawn to the stopper, not the container or the combination of the container and stopper. Thus, the structure of the container in Jesnig is not germane to the argument since the container is merely an intended use. The recitation with respect to the manner in which a claimed apparatus is intended to be employed, (i.e., liquid-tightly pressed on an inner surface of the container) fails to differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim (i.e., structural limitation of the stopper). *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Therefore, the rejection of claims 1 and 3, under 35 U.S.C. 102(b) as being anticipated by Jesnig, is hereby maintained.

Conclusion

13. No claims allowed.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 1743


shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is 571-272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 1, 2007


Jill Warden
Supervisory Patent Examiner
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